<center>**REMARKS**</center>

Claims 60-114 are pending in the application.

Claims 83-94 and 104-110 are withdrawn from consideration.

Claims 60-82, 95-103 and 111-114 stand rejected.

Claims 76-82 and 113 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 76-82 and 113 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 60-82 and 95-103 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent No. 0598469 A2 to Dunlevy.

Claims 111-114 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlevy in view of US Patent No. 5,412,738 to Brunelli, et al.

Reconsideration is requested. The rejections are traversed. No new matter is added. Claims 63-65, 76-77, and 79-80 are amended. Claims 83-94 and 104-110 are canceled. Claims 60-82, 95-103, and 111-114 remain in the case for consideration.

<center>CLAIM REJECTIONS - 35 U.S.C. § 101</center>

Claims 76-82 and 113 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Applicant respectfully traverses the rejection.

The Examiner suggests that each of the elements of claim 76 can refer to software alone, and therefore is non-statutory subject matter under 35 U.S.C. § 101, and rejects claims 77-82 and 113 on the same ground. The Examiner also states that while the Applicant has amended the preamble to recite "an identification computer system," the preamble is generally not accorded patentable weight, and the body of claim 76 appears to refer to a software system rather than a computer system (*see* Office Action dated May 9, 2007, pages 2-3 and 5). The Applicant respectfully disagrees.

MPEP 2111.02 states, "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the

balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Furthermore, "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation" (*see, e.g., Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). The Applicant includes these references to show that the preamble may be accorded patentable weight for various reasons, such as those mentioned above. The Examiner should not dismiss the preamble as having no patentable weight to make a rejection; if by considering the preamble the claim is patentable, then the preamble should be considered.

MPEP § 2106(IV)(A) states "a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent." Therefore, since the claims are directed to a machine, they are patentable under 35 U.S.C. § 101.

M.P.E.P. § 2106(IV)(B) states that "[t]he burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation." The applicant does not believe that the Office Action has met this burden with respect to claims 76-82 and 113 as the Office Action has not described how the claimed machines fall outside of the statutory categories other than to suggest that they refer to software alone. However, FIGS. 1, 3, and 4 of the application as filed show elements such as databases, network components, and communication links—as physical devices. Therefore, it is not clear to the applicant where the suggestion that the elements refer to software alone comes from.

In addition, the Examiner suggests that the "identification system of claim 76 can refer to software per se, which is not patentable" (*see* Office Action, dated May 9, 2007, page 5). However, it would be difficult, if not impossible, to receive biometric data from an individual using software alone. An interaction with an individual (i.e., a human being) requires a physical interface. When read in context, it is clear that the component configured to receive a biometric data from an individual is something more than software. The Applicant respectfully disagrees with the Examiner that the body of claim 76 lacks the necessary hardware for the system to be a computer system. Indeed, the Applicant submits that the language of claim 76, including the

preamble and the body, makes clear that the recited components are components of a computer system.

The Examiner is reminded that under the Interim Guidelines for Examination of Patents for Patent Subject Matter Eligibility:

> USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. . . . Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory. . . .

(*see* Interim Guidelines for Examination of Patents for Patent Subject Matter Eligibility, Annex IV, page 53). In claim 76, even if the Examiner's assertion that the elements could be implemented in software alone is accepted without any argument (the Applicant has previously argued why this interpretation is inappropriate), there is still sufficient hardware recited in the claims to make the claims patentable under 35 U.S.C. § 101. For example, data is transferred over "a communication link." Furthermore, biometric data is received from an individual, implying a physical interaction with an individual using a physical component.

Nevertheless, in the interest of furthering prosecution, the Applicant amends claim 76 to set forth storage means for storing a database of registration biometric samples. 35 U.S.C. 112 ¶6 states "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." The Applicant reminds the Examiner that "the 'broadest reasonable interpretation' that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination" (*en banc decision In re Donaldson Co.*, 16 F.3d 1189 (Fed. Cir. 1994); *see also* MPEP 2181). Amended claim 76 includes storage means for storing, which covers structure disclosed in the specification corresponding to storage devices of a computer system.

The Applicant further amends claim 76 to set forth an input unit to receive a biometric data from an individual, rather than using a network component to receive the biometric data. As previously explained, logic would say that receiving biometric data from an individual requires

more than software. Claim 76 now makes explicit what would otherwise have been implicitly present: that an input unit is used to receive the biometric data from the individual.

The Examiner also states that at least one of the components must be described as performing an action, and that being "configured to" perform an action does not mean that the component is performing the action nor that it is capable of performing the action. The Applicant respectfully disagrees. While it is true that a process or method claim describes performing an action, the Applicant submits that an apparatus or system claim need not describe the apparatus or system as performing an action. That an apparatus or system is configured to perform an action is sufficient to limit the claim and to clarify the relationship between structural elements of the claim. The Applicant respectfully points out that the Examiner has examined and allowed other patents, which contain elements using "configured to" language in both apparatus and system claims (*see, e.g.,* U.S. 7,039,191; U.S. 7,263,615; U.S. 7,227,948; U.S. 7,209,563; U.S. 7,209,556; U.S. 7,168,088; U.S. 7,143,294; U.S. 7,142,671; and U.S. 7,076,803).

Accordingly, claims 76-82 and 113 are patentable under 35 U.S.C. § 101 and are in proper form for allowance. The Applicant respectfully requests removal of the 35 U.S.C. § 101 rejection.

CLAIM REJECTIONS - 35 U.S.C. § 112

Claims 76-82 and 113 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant respectfully traverses the rejection.

Based at least on the amendment to claim 76, as explained above with respect to the 35 U.S.C. § 101 rejection, claim 76 particularly points out and distinctly claims the subject matter, as required by 35 U.S.C. § 112. Claims 77-82 and 113 depend from claim 76 and therefore recite at least the hardware components of claim 76. Thus, the Applicant respectfully requests removal of the 35 U.S.C. § 112 rejection.

CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 60-82 and 95-103 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent No. 0 598 469 A2 to Dunlevy ("Dunlevy"). The Applicant respectfully traverses the rejection.

The Applicant agrees with the Examiner that Dunlevy teaches that a credit card number is used to identify which anchored voice print in the database is to be retrieved for comparison (*see* Office Action dated May 9, 2007, pages 3-4; and Dunlevy, column 8, lines 20-29). Indeed, an important aspect of Dunlevy is that a match between the individual providing the voice print and the "anchored" voice print stored in the database is made possible by comparing the credit card number provided by the individual to the credit card number stored in the database. A match is found when the two credit cards match. Thereafter, the match is verified using the voice prints (*see* Dunlevy, column 8, lines 20-28 and FIG. 2).

In contrast, claim 60 sets forth "comparing the received biometric sample with at least one currently stored registration biometric sample in the set of currently stored registration biometric samples to find a match." Here, the match is made as a result of comparing the received biometric sample with at least one currently stored registration biometric sample, not from comparing credit card numbers to each other. Claims 67, 76, and 95 involve similar operations. For at least this reason, claims 60, 67, 76, and 95 are patentable over Dunlevy and are allowable, as are dependent claims 61-66, 68-75, 77-82, 96-103.

Notwithstanding the allowability of claims 60, 67, 76, and 95, the Applicant amends claims 63-65 to further clarify some embodiments of the present application. The amendments are supported by at least page 114, lines 13-18 and page 122, lines 5-8 of the specification.

Claim 63 is directed toward an identification method of claim 60, further comprising: registering at least one new registration biometric sample from at least two different individuals during a registration step; maintaining a list to designate a first subset of the registration biometric samples to be serviced by a first computer and a second subset of the registration biometric samples to be serviced by a second computer different from the first computer; and storing the first and second subsets of the registration biometric samples on both the first computer and the second computer.

Claim 64 is directed toward an identification method of claim 63, further comprising: registering at least one personal identification code from each of the at least two different individuals during the registration step; and locating the received biometric sample among one of

the first subset of registration biometric samples serviced by the first computer and the second subset of registration biometric samples serviced by the second computer responsive to the at least one personal identification code.

Claim 65 is directed toward an identification method of claim 64, wherein storing the at least one new registration biometric sample includes storing the at least one new registration biometric sample in one of the first subset of registered biometric samples serviced by the first computer and the second subset of registered biometric samples serviced by the second computer responsive to the at least one personal identification code group in the list.

One of the problems of the prior art relates to storage inefficiencies for biometrics recognition systems, which can lead to significant time lapses for identifying biometric samples of a large number of individuals in a centralized system (*see, e.g.,* specification, page 4, lines 27-31, and page 5, lines 9-20). As described at page 114, lines 13-18 and page 122, lines 5-8 of the specification, embodiments of the present invention overcome the disadvantages of the prior art. Accordingly, claims 63-65 have been amended to recite storing first and second subsets of registered biometric samples. The received biometric sample is located among the first and second subsets of registered biometric samples serviced by first and second computers, respectively. Personal identification code groups can be maintained in a list for designating and identifying which of the subsets of biometric samples should be used with respect to storing or locating biometric samples. As such, load-sharing, redundancy, and reductions in memory usage are achieved (*see, e.g.,* specification, page 114, line 18, and page 122, lines 6-7). Dunlevy fails to teach the limitations set forth in the amended claims 63-65. Based at least on their dependency from claim 60, and on their own merits, claims 63-65 are in proper form for allowance.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 111-114 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunlevy in view of US Patent No. 5,412,738 to Brunelli, et al. ("Brunelli"). The Applicant respectfully traverses the rejection.

Under MPEP 2143.01(V), if a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification" (*In re Gordon,* 733 F.2d 900, 221 USPQ 1125

(Fed. Cir. 1984). As described by Brunelli, "vectors" are extracted from a vocal or visual signal, and the vectors are then evaluated by two separate subsystems (i.e., one for vocal and one for visual) based on "distance measurements" and similarity to models stored in a data bank (*see* Brunelli, column 6, lines 44-54). According to Brunelli, the benefit of evaluating both the vocal and the visual signals "in a synergistic manner" is to "optimize the effectiveness of the recognition" (*see* Brunelli, column 5, lines 66-68). In contrast, a fundamental aspect of Dunlevy requires using a credit card number to initially find a match between the individual and a voice print (*see* Dunlevy, column 8, lines 20-28 and FIG. 2). The combination of Brunelli and Dunlevy would render the "synergistic" evaluation of Brunelli ineffective. If the effectiveness of the recognition depends on evaluating both the vocal and visual signals for a match, as taught by Brunelli, and if such synergistic evaluation is combined with a system that finds matches based on a credit card number, the synergy in the synergistic evaluation of Brunelli would be defeated because there would be no need to evaluate both the vocal and the visual signals to find the match.
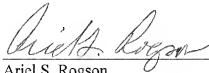
Furthermore, Dunlevy teaches a system that operates exclusively by telephone (*see, e.g.,* Dunlevy, column 2, lines 53-56, which states "[i]n particular, the person seeking approval for the purchase of goods or services with a credit card communicates via telephone with the present invention.") Such a system cannot support the possibility of a visual biometric, as required by Brunelli. Indeed, combining the credit card number via telephone matching technique of Dunlevy with the synergistic evaluation of Brunelli would render both Brunelli's and Dunlevy's inventions unsatisfactory for their intended purpose.

Even if the combination of Brunelli with Dunlevy is proper (which the Applicant disputes), these references still fail to teach each of the limitations of claims 111-114. Specifically, Brunelli teaches comparing directional derivatives of the biometric sample rather than comparing the biometric samples themselves, as recited in claims 111-114 (*see, e.g.,* Brunelli, column 12, lines 48-50 and 60-62; and column 2, lines 46-56). In contrast, embodiments of the present application, as set forth in claims 111-114, are directed to a comparison of a received biometric sample with currently stored registration biometric samples (*see, e.g.,* specification, page 9, lines 11-16; page 12, lines 1-4; page 13, lines 12-14; and page 63, lines 24-26). Based at least on the reasons set forth above, claims 111-114 are patentable over Dunlevy, even when viewed in light of Brunelli, and are therefore allowable.

For the foregoing reasons, reconsideration and allowance of claims 60-82, 95-103, and 111-114 of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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